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10/630,466

07/30/2003

Thomas Habenreich

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SCHIFF HARDIN, LLP
PATENT DEPARTMENT
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EXAMINER

CHONG CRUZ, NADJA N

ART UNIT

PAPER NUMBER

3623

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/630,466	Applicant(s) HABENREICH ET AL.	
	Examiner NADJA CHONG CRUZ	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>15 November 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This is a Non-Final office action in reply to the application filed on 30 July 2003.
2. Claims 1-26 are currently pending and have been examined.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: **Figure 4, reference character 176**. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
4. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version.

The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Specification

5. The disclosure is objected to because of the following informalities:

6. The use of the trademark MICROSOFT EXCEL on page 6, line 6 has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.
7. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks. Appropriate correction is required.

Claim Objections

8. Claim 19 is objected to because of the following informalities: it appears to be a misspelled word for *area date* instead of *area data*. Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
10. Claims 14-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
11. As per Claim 14 recites the limitation *said generic room type data*. There is insufficient antecedent basis for this limitation in the claim. Examiner interpreted the claim to read *a generic room type data* for the purposes of examination. Appropriate correction is required.
12. As per Claim 15 recites the limitation *the user*. There is insufficient antecedent basis for this limitation in the claim. Examiner interpreted the claim to read *a user* for the purposes of examination. Appropriate correction is required.

Claim Rejections - 35 USC § 101

13. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Art Unit: 3623

14. Claims 1 – 12 and 19 – 26 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).
15. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.
16. Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, claims 1 – 12 and 19 – 16 are non-statutory since they may be preformed within the human mind.
17. Claims 13 – 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As recited, claims 13-18 are directed toward a computer-implemented system, software per se. However, under the current guidelines of 35 USC 101, computer software must be tangibly embodied on a computer readable medium, and, when executed by a computer processor, perform the steps of the software. In their broadest reasonable interpretation and in light of the specification, claims 13-18, as recited, can be interpreted to be embodied on abstract mediums such as carrier waves and signals, and therefore not eligible for patent protection. Accordingly, claims 13-18 are not eligible for patent protection.

Claim Rejections - 35 USC § 102

- 18.** The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 19.** Claims 1-3, 5-6, 8-15 and 17-26 are rejected under 35 U.S.C. 102(b) as being anticipated by ARCHIBUS/FM (1999-2003) (<http://web.archive.org/web/20020527022735/http://www.archibus.com/>) aspects of are discussed in the following references:

- a. ARCHIBUS / FM Application Module, Strategic Master Planning (1999) hereinafter Reference A.
- b. ARCHIBUS / FM Application Module, Space Management (1999) hereinafter Reference B.
- c. ARCHIBUS.com (May 27, 2002) web.archive.org pages, hereinafter Reference C.
- d. Press Release (March 28, 2001) ARCHIBUS, Inc. and Siemens Medical Solutions Cooperate in Service Management Information System for Healthcare Organizations, hereinafter Reference D.
- e. ARCHIBUS / FM Application Module, Furniture & Equipment Management (1999) hereinafter Reference E.
- f. ARCHIBUS / FM Strategy for the Extended Organization, Enterprise Edition (1999) hereinafter Reference F.
- g. ARCHIBUS /FM Strategy for Administrators, FM Express (1999) hereinafter Reference G.
- h. ARCHIBUS Success Story, The Heart of the City's Child Care Community (2003) hereinafter Reference H.

Claim 1:

ARCHIBUS/FM as shown discloses a method for space planning, the method comprising:

- *receiving user requirements for a proposed health-care facility* (Reference A, Requirements Programming: which teaches that “[f]rom various sources, you will need to gather the information that will be required to make informed decisions about space needs” where ARCHIBUS/FM teaches that receives user requirements in order “to formulate your organization’s strategic planning goals”);
- *applying generic space allocations for health-care facilities to the user requirements* (Reference A, Allocation and Layout: which teaches that “[u]se the stack diagram” (e.g., generic space allocation) “to optimize your space allocation, and to present your space usage plan to others”. In addition, ARCHIBUS/FM teaches that “[f]loor room standard allocations, appropriate space bubbles (matching the allocation plan) can be automatically generated.”);
- *applying a cost database for health-care facilities planning to the user requirements* (Reference B, Choose the Report that You Need: which teaches that “[p]rogrammed Areas and Cost Reports”. ARCHIBUS/FM teaches that a cost database is applied in order to generate Cost Reports);
- *applying generic room data sheets for health-care facilities to the user requirements* (Reference B, Take Control of Your Space: which teaches that “[a]s space data is added to your drawings, such as room size, room use, type, and occupancy, it is automatically registered in data tables” (e.g., generic room data sheets));
- *applying an equipment database for health-care facilities to the user requirements* (Reference B, Working with Other Modules: which teaches that “[u]se space data with the Furniture & Equipment Management module” (e.g., equipment database) “to locate furniture and equipment on a floor plan and assign them to specific rooms”);

- *and generating output data for planning an health-care facility according to the user requirements* (Reference A, pages 1-2, Figures, which they illustrates output data for planning a facility for example: organization's current and future space needs, stack plans with space budgets, an automated blocking and layout and executive reports);

In addition, ARCHIBUS/FM discloses that it contains "seven application modules" which "are fully integrated with one another and with AutoCAD" and "allows customers to choose the right mix of application modules that best suit their organizational requirements" (Reference C: Components of ARCHIBUS/FM) where ARCHIBUS/FM product have being used for healthcare space planning in cooperation with Siemens Medical Solutions with the purpose of "serving the healthcare industry" as shown in Reference D and Reference H, ARCHIBUS/FM space planning product applied to PA Children's Hospital.

Further it is noted that the intended use of the ARCHIBUS/FM system/method for space planning of a health-care facility merely represents non-functional descriptive material wherein the intended use of the system/method does not alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data and/or intended use of the space planning system. Further, the structural elements remain the same regardless of the specific data and/or intended use of the space planning system. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.

Further a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 2:

ARCHIBUS/FM as shown discloses the following limitations:

- *wherein said output data includes area to be occupied by the health-care facility* (Reference B, Choose the Report that You Need (e.g., output): which teaches “[h]ighlight All Vacant Rooms” (e.g., area to be occupied));
- *estimated costs of constructing the health care facility* (Reference A, Who Uses Strategic Master Planning Information and Choose the Report that You Need (e.g., output): which teaches “[o]rganizational Level Forecasting Reports: areas, area changes, costs” and “Space Budget” (e.g., estimated costs of constructing) “and Period Comparisons”. In addition, ARCHIBUS/FM teaches that a “[b]usiness Managers can use strategic planning to estimate costs of future space needs.”);
- *and identification of equipment to be provided for the health-care facility* (Reference E, Choose an Inventory Method: which teaches that: “[t]agged F&E Inventories assign a unique identification number to each furniture and equipment item in a database table”);

Claim 3:

ARCHIBUS/FM as shown discloses the following limitation:

- *wherein said step of receiving the user requirements includes identification of departments to be provided in the health-care facility* (Reference A, Requirement Programming and Forecasting: which teaches “[t]his data may include departmental affinities, square footage needs, types of space required, duration of need, etc.” ARCHIBUS/FM teaches that the user requirements includes identification of departments in order “to make informed decisions about future space needs based on those of each department”);

Claim 5:

ARCHIBUS/FM as shown discloses the following limitation:

- *applying said space planning method to an existing health-care facility* (Reference A, 1st Figure, which it illustrates that a user “easily determines” his/her “organization’s current and future space needs” and Reference B, Space Management and Analyze Your Data with Predefined Reports: which teaches “perform space planning exercises”. ARCHIBUS/FM teaches that space planning method enables “to create and maintain an accurate and up-to-date record of all the areas in” the “buildings” (e.g., an existing health-care facility) “and how they are used”);

Claim 6:

ARCHIBUS/FM as shown discloses the following limitation:

- *wherein said step of generating output data includes: identifying rooms to be provided for a health-care facility* (Reference B, Choose the Report that You Need (e.g., output data): which teaches “[h]ighlight All Vacant Rooms”. ARCHIBUS/FM teaches that rooms to be provided are identified (e.g., highlighted));

Claim 8

ARCHIBUS/FM as shown discloses the following limitation:

- *wherein said step of generating output data includes: generating a total estimated cost for the health-care facility* (Reference A, page 2, Who Uses Strategic Master Planning Information and 1st Figure: which it illustrates “[s]tack plans with space budgets” (e.g., a total estimated cost) “can represent your existing allocations, your programmed needs, and/or your forecast need.” In addition, ARCHIBUS/FM teaches that a “[b]usiness Managers can use strategic planning to estimate costs of future space needs.”);

Claim 9:

ARCHIBUS/FM as shown discloses the following limitations:

- *wherein said step of generating output data includes: generating costs per department for the health-care facility* (Reference B, Choose the Right Chargeback Method: which teaches that “[u]se one of the module’s many built-in chargeback methods, or customize your own, to meet your company’s specialized billing requirements”, where “building owners can spread the cost of space, including proportional shares of common space, among tenants; accountants can bill internal departments” (e.g., generating costs per department) “for the space they occupy; or hospitals” (e.g., health-care facility) “can bill insurance carriers according to the way space is used.”);

Claim 10:

ARCHIBUS/FM as shown discloses the following limitations:

- *identifying rooms to be provided in the health-care facility by room type and applying generic room data to each of the room types in the health-care facility* (Reference B, Take Control of Your Space: which teaches that “[a]s space data is added to your drawings, such as room size, room use” (e.g., generic room data), “type” (e.g., room type), “and occupancy” (e.g., generic room data), “it is automatically registered in data tables” where rooms are identified and generic room data is applied to each room);

Claim 11:

ARCHIBUS/FM as shown discloses the following limitation:

- *identifying items of equipment to be provided for types of rooms of the health-care facility* (Reference B, Working with Other Modules: which teaches that “[u]se space data with the Furniture & Equipment Management module to locate furniture and equipment on a floor plan and assign them to specific rooms” (e.g., for types of

rooms). ARCHIBUS/FM teaches that by integrating Furniture & Equipment Management module with Space Management module enables the user to identify equipments to be provided for types of rooms);

Claim 12:

ARCHIBUS/FM as shown discloses the following limitations:

- *identifying cost of equipment for types of rooms of the health-care facility* (Reference E, Itemized Cost Tracking: which teaches that “[f]E Management allows you to track financial data” (e.g., identifying cost of equipment) “throughout the life of an asset: its original value, current value, accumulated depreciation, and when sold, the gain or loss on the asset” where a user “can create a variety of summary reports, according to cost center, property type, and so on” for example “Equipment Standard Book” and “Equipment Inventory Counts by Standard by Department”);

Claim 13:

ARCHIBUS/FM as shown discloses a computer-implemented system for planning, the computer-implemented system comprising:

- *an input process for accepting user information on a requested health-care facility* (Reference C, ARCHIBUS/FM Applications, 1st ¶: which teaches that “[o]nce information is entered” (e.g., an input process for accepting user information) “into the system” (e.g., a requested health-care facility), “it is automatically reflected in other relevant areas, ensuring accurate, up-to-date information”);
- *generic room data and cost data and area data for room types in a health-care facility* (Reference B, Take Control of Your Space and Choose the Right Chargeback Method: which teaches that “[a]s space data is added to your drawings, such as room size, room use” (e.g., generic room data), “type” (e.g., room type), “and occupancy” (e.g., generic room data), “it is automatically

registered in data tables” where rooms are identified and generic room data is applied to each room and cost data for room types is added to data tables in order that “hospitals can bill insurance carriers according to the way spaces is used (e.g., room types));

- *a process framework for applying the generic room data and area data and cost data to the user information* (Reference B, page 2, last Figure, which it illustrates “[e]xecutive reports allow you to examine your current space usage, analyze forecast space needs, compare proposed layouts against existing conditions, and examine the historical use of space by budget category”. ARCHIBUS/FM teaches that generic room data, area data and cost data are applied to the user information in order to generates executive reports);
- *and a display process for displaying output data for the health-care facility including area information and cost information* (Reference A, Choose the Report that You Need: which teaches a “[p]rogrammed Areas and Cost Reports” (e.g., output data);
- *and equipment information* (Reference E, Choose the Report that You Need: which teaches a the following reports (e.g., output data) of equipment information: “Equipment Standards Book”, “Equipment Layout Report, Equipment Inventory by Equipment Standard, Equipment Inventory Counts by Standard by Department, Equipment Disposition”);

In addition, ARCHIBUS/FM discloses that it contains “seven application modules” which “are fully integrated with one another and with AutoCAD” and “allows customers to choose the right mix of application modules that best suit their organizational requirements” (Reference C: Components of ARCHIBUS/FM) where ARCHIBUS/FM product have being used for healthcare space planning in cooperation with Siemens Medical Solutions with the purpose of “serving the healthcare industry” as shown in Reference D and Reference H, ARCHIBUS/FM space planning product applied to PA Children's Hospital.

Further it is noted that the intended use of the ARCHIBUS/FM system/method for space planning of a health-care facility merely represents non-functional descriptive material wherein the intended use of the system/method does not alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data and/or intended use of the space planning system. Further, the structural elements remain the same regardless of the specific data and/or intended use of the space planning system. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.

Further a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 14:

ARCHIBUS/FM as shown discloses the following limitations:

- *wherein a generic room type data includes room information for types of rooms in health-care facilities* (Reference B, Take Control of Your Space: which teaches that “[a]s space data is added to your drawings, such as room size, room use, type and occupancy” (e.g., generic room data), “it is automatically registered in data tables” where types of rooms includes generic room data);
- *and said process framework applies said generic room type data to the user information* (Reference G, page 1, Figure: which it illustrates “[t]he Highlight Rooms by Standard report uses highlights to distinguish rooms by standard configurations” (e.g., generic room type data). ARCHIBUS/FM teaches that an output as shown in the Figure is generated after applying generic room type data (e.g., rooms with standard configuration) to the user information);

Claim 15:

ARCHIBUS/FM as shown discloses the following limitations:

- *wherein said input process includes identification of available departments for selection by a user* (Reference G, FM Express, What is Express and Easy to Use FM: which teaches that ARCHIBUS/FM enables an administrative user “to generate room lists and occupancy plans, track maintenance work, determine vacant suites” then a user identify and select available departments in order that ARCHIBUS/FM highlights “vacant stations and identify under-utilized rooms”. It is implicitly disclosed available department have been previously selected by the user in order to identify vacant stations and under-utilized rooms.);

Claim 17:

ARCHIBUS/FM as shown discloses the following limitations:

- *wherein said display process displays output data for common areas of the health-care facility and for department areas of the health-care facility* (Reference B, Who Uses Space Inventory Information and Choose the Report that You Need: which teaches that “[a]ccountants can use space data to charge departments for the areas they occupy, plus their share of common areas.” ARCHIBUS/FM teaches that a display of output data for common areas are generated through reports such as “Chargeback Analysis -Group Chargeback -Financial Statement”, “Departmental Analysis, Departmental Stack Plan” and/or “Occupancy Plan”);

Claim 18:

ARCHIBUS/FM as shown discloses the following limitations:

- *wherein said cost data displayed by said display process includes an estimate for total cost of the health-care facility* (Reference A, page 2, Who Uses Strategic Master Planning Information and 1st Figure: which it illustrates “[s]tack plans with space budgets” (e.g., a total estimated cost) “can represent your existing

allocations, your programmed needs, and/or your forecast need.” In addition, ARCHIBUS/FM teaches that a “[b]usiness Managers can use strategic planning to estimate costs of future space needs.”);

- *and costs for systems within the health-care facility* (Reference E, Itemized Cost Tracking: which teaches that “[f]&E Management allows you to track financial data” (e.g., cost for systems) “throughout the life of an asset: its original value, current value, accumulated depreciation, and when sold, the gain or loss on the asset” where a user “can create a variety of summary reports, according to cost center, property type, and so on”);

Claim 19:

ARCHIBUS/FM as shown discloses a computer-implemented method for planning, the computer-implemented method comprising:

- *presenting a listing of departments of health-care facilities to a user for selection; receiving selections of departments from the user for a health-care facility* (Reference B, Choose the Report that You Need: which teaches reports related with information by departments: “Highlight Groups by Departments, Departmental Analysis, Departmental Stack Plan, Rooms by Department” and “Highlight Rooms by Department” where ARCHIBUS/FM teaches that a list of department is presented to a user for input selection in order to generate reports by departments);
- *requesting information on each selected department from the user* (Reference A, Requirements Programming: which teaches “[f]rom various sources, you will need to gather the information that will be required to make informed decisions about space needs. This data may include departmental affinities, square footage needs, types of space required, duration of need, etc.” ARCHIBUS/FM teaches that the Strategic Master Planning module allows a user to manage “single property, a

campus, or a diverse portfolio of buildings". It is implicitly disclosed that information is requested from each selected department);

- *receiving said information from said user for selected departments* (Reference A, Requirements Programming: which teaches that "[u]se the Requirements Programming activity to inventory the data you will need to formulate your organization's strategic planning goals." ARCHIBUS/FM teaches that to make an inventory of the data, information have been received);
- *applying a process framework to said selections and said information from said user, said process framework applying generic room type data and cost data and area data to said selections and said information from said user* (Reference B, page 2, last Figure, which it illustrates "[e]xecutive reports allow you to examine your current space usage, analyze forecast space needs, compare proposed layouts against existing conditions, and examine the historical use of space by budget category". ARCHIBUS/FM teaches that generic room data, area data and cost data are applied to the user information and selections in order to generate executive reports);
- *generating an output of cost information and area information for the health-care facility* (Reference A, Choose the Report that You Need: which teaches a "[p]rogrammed Areas and Cost Reports" (e.g., output data generated));

In addition, ARCHIBUS/FM discloses that it contains "seven application modules" which "are fully integrated with one another and with AutoCAD" and "allows customers to choose the right mix of application modules that best suit their organizational requirements" (Reference C: Components of ARCHIBUS/FM) where ARCHIBUS/FM product have been used for healthcare space planning in cooperation with Siemens Medical Solutions with the purpose of "serving the healthcare industry" as shown in Reference D and Reference H, ARCHIBUS/FM space planning product applied to PA Children's Hospital.

Further it is noted that the intended use of the ARCHIBUS/FM system/method for space planning of a health-care facility merely represents non-functional descriptive material wherein the intended use of the system/method does not alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data and/or intended use of the space planning system. Further, the structural elements remain the same regardless of the specific data and/or intended use of the space planning system. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.

Further a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 20:

ARCHIBUS/FM as shown discloses the following limitations:

- *wherein said step of generating generates an output of equipment information for the health-care facility* (Reference E, Choose the Report that You Need: which teaches the following reports (e.g., outputs) of equipment information: "Equipment Standards Book", "Equipment Layout Report, Equipment Inventory by Equipment Standard, Equipment Inventory Counts by Standard by Department, Equipment Disposition History");

Claim 21:

ARCHIBUS/FM as shown discloses the following limitations:

- *wherein said cost information includes total estimated cost information* (Reference A, page 2, Who Uses Strategic Master Planning Information and 1st Figure: which it illustrates "[s]tack plans with space budgets" (e.g., a total estimated cost) "can

represent your existing allocations, your programmed needs, and/or your forecast need.” In addition, ARCHIBUS/FM teaches that a “[b]usiness Managers can use strategic planning to estimate costs of future space needs.”);

- *and estimated cost information per selected department* (Reference B, Choose the Right Chargeback Method: which teaches that “[u]se one of the module’s many built-in chargeback methods, or customize your own, to meet your company’s specialized billing requirements”, where “building owners can spread the cost of space, including proportional shares of common space, among tenants; accountants can bill internal departments” (e.g., generating costs per selected department) “for the space they occupy; or hospitals” (e.g., health-care facility) “can bill insurance carriers according to the way space is used.”);
- *and said area information includes total area information and area information per department* (Reference B, Choose the Report that You Need: which teaches that total area information is included at least in the “Departmental Analysis” or “Departmental Stack Plan” reports and area information per department is included at least in the “Group Standard Analysis-Summary” or “Rooms by Department” reports);

In addition, ARCHIBUS/FM teaches that “[v]arious methods for collecting and organizing space information are provided for you, to meet your particular reporting requirements.” (Reference B, Take Control of Your Space).

Claim 22:

ARCHIBUS/FM as shown discloses the following limitations:

- *wherein said cost information and area information includes information for common areas and for selected department areas* (Reference B, Who Uses Space Inventory Information and Choose the Report that You Need: which teaches that “[a]ccountants can use space data to charge departments for the areas they

occupy, plus their share of common areas.” ARCHIBUS/FM teaches that cost information and area information includes information for common areas for each department as shown in the following reports: “Chargeback Analysis -Group Chargeback -Financial Statement”, “Departmental Analysis, Departmental Stack Plan” and/or “Occupancy Plan”);

Claim 23:

ARCHIBUS/FM as shown discloses the following limitations:

- *applying the method steps to a proposed health-care facility* (Reference A, page 1, Figure, which it illustrates an effective way to use current data or historical layouts to “easily determine your organization's current and future space needs” and Reference B, Space Management and Analyze Your Data with Predefined Reports: which teaches “perform space planning exercises”. ARCHIBUS/FM teaches that space planning method enables “to create and maintain an accurate and up-to-date record of all the areas in” the “buildings” (e.g., a proposed health-care facility) “and how they are used”);

Claim 24:

ARCHIBUS/FM as shown discloses the following limitations:

- *applying the method steps to an existing health-care facility* (Reference B, Space Management and Analyze Your Data with Predefined Reports: which teaches “perform space planning exercises”. ARCHIBUS/FM teaches that space planning method enables “to create and maintain an accurate and up-to-date record of all the areas in” the “buildings” (e.g., an existing health-care facility) “and how they are used”);

Claim 25:

ARCHIBUS/FM as shown discloses the following limitations:

- *wherein said step of applying the process framework draws data from user requirements* (Reference A, Requirements Programming: which teaches that “[f]rom various sources, you will need to gather the information that will be required to make informed decisions about space needs” where ARCHIBUS/FM teaches that the process framework draws user requirements in order “to formulate your organization’s strategic planning goals”);
- *and generic space allocations* (Reference A, Allocation and Layout: which teaches that “[u]se the stack diagram” (e.g., generic space allocation) “to optimize your space allocation, and to present your space usage plan to others”. In addition, ARCHIBUS/FM teaches that “[f]loor room standard allocations, appropriate space bubbles (matching the allocation plan) can be automatically generated.”);
- *and a cost database* (Reference B, Choose the Report that You Need: which teaches that “[p]rogrammed Areas and Cost Reports”. ARCHIBUS/FM teaches that a cost database is applied in order to generate Cost Reports);
- *and an equipment database* (Reference B, Working with Other Modules: which teaches that “[u]se space data with the Furniture & Equipment Management module” (e.g., equipment database) “to locate furniture and equipment on a floor plan and assign them to specific rooms”);
- *and generic room data* (Reference B, Take Control of Your Space: which teaches that “[a]s space data is added to your drawings, such as room size, room use, type, and occupancy, it is automatically registered in data tables” (e.g., generic room data));

Claim 26:

ARCHIBUS/FM as shown discloses the following limitations:

- *receiving different user information after said step of generating the output; and providing updated output information based on the different user information* (Reference B, Space Management and Take Control of Your Space: which teaches that “[t]he ARCHIBUS/FM Space Management module enables you to create and maintain an accurate” (e.g., receive different user information) “and up-to-date record” (e.g., updated output information) “of all the areas in your buildings and how they are used—a living electronic inventory of your space.” In addition, ARCHIBUS/FM provides “[v]arious methods for collecting and organizing space information” in order to “to meet” the user’s “particular reporting requirements.”);

Claim Rejections - 35 USC § 103

- 20.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 21.** Claims 4, 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over ARCHIBUS/FM as applied to claims 1-3, 5-6, 8-15 and 17-26 above in view of Miller et al, **Hospital and healthcare facility Design**, 2002, hereinafter “Miller”.

Claim 4:

While ARCHIBUS/FM clearly teaches being used in the Children’s Hospital of Pittsburgh as shown in Reference H, in order to “[f]ully customize” the hospital needs (e.g., per department). ARCHIBUS/FM does not expressly teach the following limitation, However, Miller in an analogous art of facility design for the purpose of planning and gathering healthcare needs and requirements before planning (Chapter 7, pages 160-161) as shown, does:

- *wherein said step of receiving the user requirements includes identification of expected outpatient services* (Chapter 7, Surgery Facilities, page 160, which teaches that “[t]oday, in many hospitals, outpatient surgery” (e.g., outpatient services) makes up 75 to 80 percent of the surgery load” where Miller teaches that [t]his means that designers must devote careful consideration to outpatient waiting and reception areas, staging and holding areas, and recovery needs.” (e.g., identification of expected outpatient services));
- *and desired number of patient beds per department* (Chapter 7, page 161: which teaches that one of the requirements to plan the number and type of a surgical facility (e.g., healthcare facility) is to identify the “[n]umber of critical-care beds available for surgical patients” (e.g., desired number of patient beds available);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine ARCHIBUS/FM with the user requirements of expected outpatient services and number of patient beds as taught by Miller because “[i]t is critically important for hospital planner to access surgery” (e.g., healthcare) “need before design – of new construction or renovation- begins”. (Miller, Chapter 7, page 160).

Claim 7:

While ARCHIBUS/FM clearly teaches being used in the Children’s Hospital of Pittsburgh (e.g., healthcare facility), as shown in Reference H. ARCHIBUS/FM does not expressly teach the following limitation, However, Miller in an analogous art of facility design for the purpose of identify supporting rooms for primary rooms (Chapter 3, pages 63-64) as shown, does:

- *wherein said step of generating output data includes: identifying associated supporting rooms for primary rooms of the health-care facility* (Chapter 3, New Markets, New Design Principles, pages 63-64: “[i]maging” (e.g., supporting room) “is located for easy accessibility from emergency” (e.g., a primary room), “[t]wo areas within the department-trauma and primary care-” (e.g., primary rooms) “share

support areas and staff" which Miller teaches that is old and well known in the art to identify associated supporting rooms for primary rooms);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine ARCHIBUS/FM with the identification of associated supporting rooms for primary rooms as taught by Miller because it provides an "optimal use of professional staff" by identifying and combining traditional areas "through both physical construction and staff cross-training" in order to improve flexibility between staff and equipment. (Miller, Chapter 3, page 63).

Claim 16:

While ARCHIBUS/FM clearly teaches being used in the Children's Hospital of Pittsburgh as shown in Reference H, in order to "[f]ully customize" the hospital needs (e.g., each selected department). ARCHIBUS/FM does not expressly teach the following limitation, However, Miller in an analogous art of facility design for the purpose of planning and gathering healthcare needs and requirements before planning (Chapter 7, pages 160-161) as shown, does:

- *wherein said input process includes an input process for receiving information from a user on a number of bed for each selected department* (Chapter 7, page 161: which teaches that one of the requirements to plan the number and type of a surgical facility (e.g., healthcare facility) is to identify the "[n]umber of critical-care beds available for surgical patients" (e.g., desired number of patient beds available);
- *and a number of outpatient services for each selected department* (Chapter 7, Surgery Facilities, page 160, which teaches that "[t]oday, in many hospitals, outpatient surgery" (e.g., outpatient services) makes up 75 to 80 percent of the surgery load" where Miller teaches that [t]his means that designers must devote careful consideration to outpatient waiting and reception areas, staging and holding areas, and recovery needs." (e.g., identification of expected outpatient services));

- *and a number of health-care professionals for each selected department of the health-care facility* (Chapter 7, page 161: which teaches that one of the requirements to plan the number and type of a surgical facility (e.g., healthcare facility) is to identify the "[p]hysician population (for example, is it high in orthopedic surgery, urology, etc)" (e.g., number of health-care professionals for each selected department));

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine ARCHIBUS/FM with the user requirements of expected outpatient services and number of patient beds as taught by Miller because "[i]t is critically important for hospital planner to access surgery" (e.g., healthcare) "need before design – of new construction or renovation- begins". (Miller, Chapter 7, page 160).

Conclusion

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- ARCHIBUS / FM Application Module, **Building Operation Management** (1999) which discloses a computerized maintenance management system that analyzes maintenance histories and expenditures for future demand in a facility.
 - Kimmel et al, **Going for a Ride on Archibus**, *Facilities Design & Management*; Jan 1992; 11, 1 which discloses an in-depth review of Archibus/FM 5.0, an AutoCad-based space management product that links CAD drawings, databases, and spreadsheets.
 - **Space planning with Archibus/FM Interiors**; Mar 1993; 152, 3; Career and Technical Education which discloses software with planning and design capabilities that combine graphics with databases.
 - Yankee, **Automated space planning for large spaces**, *Journal of Property Management*; Sep/Oct 1994; 59, 5; which discloses an information system

integrating a relational database and geographic information for space planning in a large space.

- Thomson (US 4,642,780) discloses a space planning/facilities management system using priority and affinity colors.
- Burns et al (US 5,189,606) discloses a totally integrated construction cost estimating, analysis, and reporting system.
- Crane (US 5,748,907) discloses a medical facility and business: automatic interactive dynamic real-time management.
- Isherwood (US 5,918,219) discloses a system and method for estimating construction project costs and schedules based on historical data.
- Patrucco (US 2003/0046040 A1) discloses a method and system for architectural space programming for a facility.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nadja Chong** whose telephone number is **571.270.3939**. The Examiner can normally be reached on Monday-Friday, 8:00am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **BETH VAN DOREN** can be reached at **571.272.6737**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

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16 July 2008

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